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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,602

04/27/2006

Marcello Fratini

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EXAMINER

TUROCZY, DAVID P

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

07/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/577,602	Applicant(s) FRATINI ET AL.	
	Examiner DAVID TUROCY	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/24/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/27/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's preliminary amendments, filed 6/24/2009, have been fully considered and reviewed by the examiner. Claims 1-15 are pending in the instant application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for including elemental sulphur, does not reasonably provide enablement for a compound capable of liberating elemental sulphur. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The nature of the invention involves application of elemental sulphur compound with a polymer binders to provide treatment of textile with a users foots. The claims as written requires "a compound capable of liberating elemental sulphur", however, the state of the prior art is silent to various compounds capable of being utilized in such a manner and while the skill of one ordinary in the art is relatively high, the claims required liberating elemental sulphur from said compound which is a highly exact science with little predictability. Additionally, while the specification clearly describes with sufficient specificity the application of elemental sulphur with polymer

Art Unit: 1792

binder functions as claimed, the specification fails to include any working examples or direction as to a representative number of species of the seemingly infinite number of possible compounds that capable of "liberating elemental sulphur" when utilized in the manner claimed (i.e. on fabric with a polymeric binder), that would result in the proper and predictable results without undue experimentation. This undue experimentation would encompass determining which compounds, selected from a seemingly infinite number of compounds, successfully liberate elemental sulphur when used on a fabric with a polymeric binder as required by the present claims. See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10-11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4260660 by McCarter, hereafter McCarter.

McCarter discloses a composition comprising sulphur and acrylic latex as required by the claims and a textile impregnated or treated with the composition (examples).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 3, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 9285483, hereafter JP 483 in view of US 6077794 by Tabata et al. and McCarter.

JP 483 discloses a textile associated with a users foot and blending the fibers with a sulphur as an active ingredient that has high antibacterial effect, controls athletes foot (abstract). JP 483 fails to disclose impregnating the fabric with the sulphur composition containing resin. However, Tabata discloses known methods for deodorizing fabric includes blending the deodorizing material into the fibers or attaching the sulphur to the surface of the fabric by using a resin binder (column 1, lines 20-35). Additionally, McCarter discloses a known and suitable technique for attaching sulphur to the surface of a fabric material includes impregnation of sulphur powder and acrylic type resin. Therefore taking the references collectively, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified JP 483 to have deposited the sulphur by coating the fabric as suggested by Tabata using the technique as taught by McCarter with a reasonable expectation of predictable results because Tabata discloses coating fibers with deodorizers is known in the art and McCarter discloses a known and suitable method of attaching sulphur to the surface of fabric.

Art Unit: 1792

As for the requirement of releasing over time, this is clearly inherent in the process because the prior art makes obvious each and every step of the claimed invention, including using an acrylic latex binder and elemental sulphur compound and thus the results obtained by the prior art must necessarily be the same as though obtained by the applicant, unless the applicant is using other process steps that are not presently claimed.

Claim 2-3: McCarter discloses the limitations of these claims (see examples) and using such would have been obvious for the reasons set forth above.

Claim 6: McCarter discloses a known and suitable technique for attaching sulphur to the surface of a fabric material includes impregnation of sulphur powder and acrylic type resin, but fails to disclose the concentration of the ingredients. However, the concentration of the binder and the sulphur is a known result effective variable, directly effecting the treatment of the fabric and the binding properties. Therefore, it would have been obvious to one of ordinary skill in the art to have determined the appropriate and optimal concentration of sulphur and resin with a reasonable expectation of successful results. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to determine the optimum values for the concentrations, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim 8: The polymer is acrylic-latex resin, which as evidenced by the applicant's specification is "a selected adhesive utilized for assembling a shoe or part thereof", where the claims fail to require a shoe or part thereof.

8. Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4260660 by McCarter, hereafter McCarter.

McCarter discloses a known and suitable technique for attaching sulphur to the surface of a fabric material includes impregnation of sulphur powder and acrylic type resin, but fails to disclose the concentration of the ingredients. However, the concentration of the binder and the sulphur is a known result effective variable, directly effecting the treatment of the fabric and the binding properties. Therefore, it would have been obvious to one of ordinary skill in the art to have determined the appropriate and optimal concentration of sulphur and resin with a reasonable expectation of successful results. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to determine the optimum values for the concentrations, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ewing et al (Sulphur Impregnated Clothing to Protect Against Chiggers) in view of US 6077794 by Tabata et al. and McCarter.

Art Unit: 1792

Ewing discloses a textile associated with a users foot and blending the fibers with a sulphur as an active ingredient (abstract). Ewing fails to disclose impregnating the fabric with the sulphur composition containing resin. However, Tabata discloses known methods for deodorizing fabric includes blending the deodorizing material into the fibers or attaching the sulphur to the surface of the fabric by using a resin binder (column 1, lines 20-35). Additionally, McCarter discloses a known and suitable technique for attaching sulphur to the surface of a fabric material includes impregnation of sulphur powder and acrylic type resin. Therefore taking the references collectively, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Ewing to have deposited the sulphur by coating the fabric as suggested by Tabata using the technique as taught by McCarter with a reasonable expectation of predictable results because Tabata discloses coating fibers with deodorizers is known in the art and McCarter discloses a known and suitable method of attaching sulphur to the surface of fabric.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID TUROCY whose telephone number is (571)272-2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1792

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David Turocy/
Examiner, Art Unit 1792